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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,870	09/18/2003	Steven Edward Atkin	AUS920030661US1	8464
35525 7590 02/23/2007 IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NEWAY, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/666,870

**Applicant(s)**

ATKIN ET AL.

**Examiner**

Samuel G. Neway

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is responsive to the Application filed on September 18, 2003.

#### ***Claim Objections***

2. Claims 3 and 19 are objected to because of the following informalities:

Claim 3 recites the limitation "wherein the target language includes is one of ..." which is believed to be a typographical error.

Claim 19 recites, "the translation mode include a default ..." which is believed to be a typographical error.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11 – 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11 – 16 are directed to a data processing system; however it is reasonable to interpret the means recited as part of the system as being software (computer program) alone as evidenced by claims 17 – 20.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such

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claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

Claims 17 – 20 are directed to a computer program product, which may be reasonably interpreted as being a computer listings per se.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

Also, the computer readable medium recited in claims 17 - 20, in accordance with Applicant's specification, may be an electromagnetic signal. This subject matter is not limited to that which falls within a statutory category of invention because it is not

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limited to a process, a machine, a manufacture, or a composition of matter. Instead, it includes a form of energy, which does not fall within a statutory category.

Amending the claims to recite "recordable-type media" would overcome this rejection in a manner consistent with Applicant's specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 6, 8 – 12, 16 – 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rojas et al. (USPN 6,425,123).

Claim 1:

Rojas discloses a method for testing a software program (Abstract), the method comprising the computer implemented steps of:

responsive to a user input, containing text in a source language, entered through a computer interface in the data processing system, translating the text from the source language to the target language to form translated text ("converts ... base language data ... and performs a mock translation on it to produce internationalization test data" col. 2, lines 48-62);

automatically inserting the translated text into a user interface of the software program to be tested to form inserted, translated text, wherein the software program is written in the target language ("displayed in a software application ...", col. 2, lines 48-62);

and determining whether the software program functions correctly using the inserted, translated text ("the programmer ... is able to easily recognize many internationalization errors", col. 2, lines 48-62).

Claim 2:

Rojas discloses the method of claim 1, wherein the computer interface includes an option for a user to enable and disable translation of the text (Figs 4,5, and related text).

Claim 3:

Rojas discloses the method of claim 1, wherein the target language is one of a single-byte language or a multi-byte language ("to be translated into Japanese or other languages that use double-byte character sets ", col. 7, lines 2-3).

Claim 4:

Rojas discloses the method of claim 1, wherein the translating step uses a set of translation rules ("based on internationalization guidelines ...", col. 5, lines 1-3).

Claim 5:

Rojas discloses the method of claim 4, wherein a set of translation rules may be defined in a configuration file by a user at any time ("may vary these figures to fit the particular translation ... ", col. 5, lines 20-22).

Claim 6:

Rojas discloses the method of claim 4, wherein a set of translation rules may be applied upon restarting of the computer interface ("may vary these figures to fit the particular translation that will be made on the software ", col. 5, lines 20-22. Note that it is inherent for these rules to be applied at any time including when the computer interface is restarted).

Claim 8:

Rojas discloses the method of claim 1, wherein inserting step is initiated in response to a user input to commit the translated text input ("testing tool provides an easy way for the programmer to visually inspect the software package ...", col. 4, lines 46-52).

Claim 9:

Rojas discloses the method of claim 1, wherein translating step is performed using a set of instructions and configuration files in a network data processing system ("based on internationalization guidelines ...", col. 5, lines 1-3, "this method and system can be easily adapted for use on ... network of systems", col. 4, lines 30-33).

Claim 10:

Rojas discloses a data processing system comprising: a bus system; a memory, wherein the memory contains a set of instructions; and a processing unit (Fig. 1 and related text),

wherein the processing unit executes the set of instructions to translate text from a source language to a target language to form translated text in response to a user

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input, containing text in a source language, entered through a computer interface in the data processing system; automatically insert the translated text into a user interface of the software program to be tested to form inserted, translated text, wherein the software program is written in the target language; and determine whether the software program functions correctly using the inserted, translated text ("converts ... base language data ... and performs a mock translation on it to produce internationalization test data" col. 2, lines 48-62).

Claims 11, 16:

Claims 11 and 16 are similar in scope and content to claim 1 and are rejected with the same rationale.

Claim 12:

Claim 12 is similar in scope and content to claim 5 and is rejected with the same rationale.

Claims 17, 18:

Claims 17 and 18 are similar in scope and content to claims 1 and 5, and are rejected with the same rationale.

Claim 20:

Rojas discloses the computer program product of claim 17, wherein the computer interface includes an option for a user to enable and disable translation of the text (Figs 4,5, and related text).



***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7, 13 – 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rojas et al. (USPN 6,425,123) in view of See et al. (USPN 5,572,668).

Claim 7:

Rojas discloses the method of claim 1, wherein the translating step comprises: preserving selected source language characters in the text (col. 4, lines 58-64), but he does not explicitly disclose replacing selected source language characters with target language characters

See discloses a similar universal national language program testing method where selected source language characters are replaced with target language characters ("substituting a predefined "problem" character for the particular English language ASCII character", col. 6, lines 53-56).

It would have been obvious to one with ordinary skill in the art at the time of the invention to replace selected source language characters with target language characters in Rojas method in order to provide a "mechanism for uncovering errors in localized programs" (See, col. 7, lines 1-2).

Claims 13 – 14:

Rojas discloses the data processing system of claim 12, wherein the translation mode includes a default translation (col. 2, lines 48-62) with a popup window (window of Fig. 3) displaying translated text, but he does not explicitly disclose a look up translation. See discloses a "look-up table" (col. 2, lines 19-23) as claimed in the instant claims.

It would have been obvious to one with ordinary skill in the art at the time of the invention to use lookup tables to replace selected source language characters with target language characters in Rojas method in order to provide a "mechanism for uncovering errors in localized programs" (See, col. 7, lines 1-2).

Claim 15:

Claim 15 is similar in scope and content to claim 7 and is rejected with the same rationale.

Claim 19:

Claim 19 is similar in scope and content to claim 13 and is rejected with the same rationale.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yang (USPN 6,530,039) discloses a system and method for testing various language versions of an application program.

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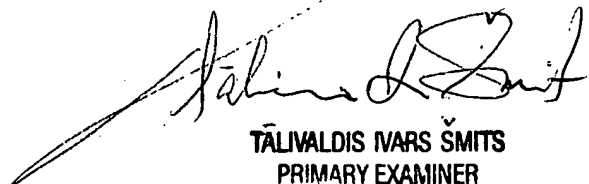
Watanabe et al. (USPN 6,185,729) discloses a system for developing and testing internationalized software.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN



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PRIMARY EXAMINER